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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,647	03/29/2004	Michael Lashmet	31905-74377	4151

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INDIANAPOLIS, IN 46204

EXAMINER

LAYNO, BENJAMIN

ART UNIT PAPER NUMBER

3711

DATE MAILED: 08/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/811,647

Applicant(s)

LASHMET, MICHAEL

Examiner

John W. Ebrecht

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 19 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 recites the limitation "the first portion." There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5-8, and 10-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Earnest Jr. (U.S. Patent No. 4,982,683). Earnest Jr. discloses a plurality of hand-held signs/paddles having a handle portion (30) and a second portion for displaying indicia with indicia means. The signs/paddles are double-sided to have a front and a rear panel and relatively thin in comparison to the length and width of the signs/paddles. The signs/paddles further have a second portion that is of equal thickness as the handle portions and therefore,

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are stackable for compact use and storage. Regarding the intended use of the invention, applicant must distinguish over the prior art with structural limitations and not functional limitations in apparatus claims. See *In Re Schreiber* 44 USPQ 2d 1429. By broadly interpreting the handle portion of the signs of Earnest Jr. to encompass the openings (16), the signs then read on claim 5 by comprising a retainer penetrating through the handle portions of the signs, thereby enabling the signs to be loosely assembled together into a kit of signs. Regarding claim 10, the second portion of the sign where the main indicia is printed is larger than the handle portion (30) in the direction along which the indicia is printed. Regarding claim 17, an axis perpendicular to the signs is interpreted as any axis since any axis defined along the signs can be interpreted as being perpendicular to a sign or a face, therefore, since the signs can rotate about the axis that is defined by the top edge of the sign in the plane defined by the indicia displaying face of the sign, and this axis is perpendicular to the side edge of the sign, then it reads on claim 17. Regarding claim 18, Earnest Jr. discloses preferred dimensions (col. 3, lines 50-55) that are not the same as the dimensions of the applicant. However, it has been held that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. One skilled in the art would have selected an ideal size for the second portion based on the size of the indicia that is being displayed. Regarding claim 20, Earnest Jr. discloses that the signs are made out of any suitable material and gives the example of plastic or aluminum. Furthermore, it has been held that selection of a preferred material has been held as unpatentable over the prior art. See *In Re*

Leshin 227 F.2d 197, 125 USPQ 416. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference of Earnest Jr. to be manufactured out of any suitable material like cork board or pressboard in order for the signs to be more ergonomic based on their intended function.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Earnest Jr. in view of Spelman (PG Pub No. US 2002/0133988). While the reference of Earnest Jr. includes a handle that could be interpreted to define an axis in both the horizontal and vertical direction, and therefore inherently would also bisect the sign face's horizontal axis. However, if this interpretation is in question, Spelman clearly teaches the concept of having hand held signs with a thinner handle in relation to the wider sign face. The handle (16) of Spelman protrudes out from one edge of the sign face (18) and by interpreting the direction from which the handle protrudes as the longitudinal axis that the handle defines, it is shown that this axis would bisect the horizontal axis along the direction of the sign's printed indicia. In view of Spelman, it would have been obvious to one of ordinary skill in the art at the time of invention to

modify the signs of Earnest Jr. to provide them with a protruding handle in order to make the signs easier to grip and to hold up.

***Conclusion***

6. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John W. Ebrecht whose telephone number is (571) 272-8959. The examiner can normally be reached on Monday - Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Ebrecht  
Art Unit 3711



**EUGENE KIM**  
SUPERVISORY PATENT EXAMINER